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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,228	12/08/2003	Ronald P. Akialis JR.	57391/18 (50-03-060)	2495
35744 7590 07/05/2007 KRAMER LEVIN NAFTALIS & FRANKEL LLP INTELLECTUAL PROPERTY DEPARTMENT 1177 AVENUE OF THE AMERICAS NEW YORK, NY 10036			EXAMINER JOHNSON, GREGORY L	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 07/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/730,228	Applicant(s) AKIALIS ET AL.	
	Examiner GREGORY JOHNSON	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/08/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the application filed December 8, 2003.

Claims 1-25 have been examined.

Specification

2. The disclosure is objected to because of the following informalities:

Page 12 of the disclosure, third paragraph cites:

"the authorizing party returns the edit failure information to the biller and at step 66 sends edit failure information to the consumer"

The language used provides a different interpretation of what happens in step 66 when compared FIG. 2 of the drawings. For examination purposes, the Examiner will refer to FIG. 2 as the accurate representation of what happens in step 66.

Appropriate correction is required.

Claim Objections

3. Claims 13-15, 19 and 24 are objected to because of the following informalities:

Page 4 of the disclosure, first paragraph cites:

The authorizing party has the credit/debit card company check the confirmation number against the other card information received to make certain that they correctly match with the company records, and the authorizing party then makes an authorization decision and communicates it to the biller and the consumer. This helps reduce credit/debit card fraud.

The meaning of the phrase "confirmation number" used in the claims and in the disclosure is unclear. The only paragraph within the disclosure that contains the phrase "confirmation number", is explaining the use of a "verification code". For examination

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purposes, the Examiner will interpret the meaning of "confirmation number" to be "verification code".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 7-8, 10, 12-15, 20-22 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Byrne et al. (hereinafter Byrne), Pub. No. 20030229590.

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

As to claims 1 and 13-15, Byrne discloses a method of authorizing bill payments (see Abstract), said method comprising:

(a) receiving at an authorization website information sent by a biller (e.g. merchant, seller) through the worldwide web identifying the payor, and specifying the amount to be paid and the account to be used in making the payment (paragraphs 0010 and 0119; and FIG. 4 and 6);

(b) determining whether the payment should be authorized (paragraph 0058);

(c) transmitting through the worldwide web to a website of the biller authorization information authorizing the payment or refusing authorization (paragraph 0058);

(d) whereby authorization notification (e.g. receipt) can be given to the payor from a website of the biller without disclosing that the authorization was obtained by anyone other than the biller (e.g. customer never leaves merchants site; see Table 1 and paragraph 0107), and

(e) sending an electronic notification to the payor that the payment has been authorized (e.g. automatically e-mail payment confirmation; paragraph 0045);

said information received at said authorization website including a credit or debit card number and confirmation number (i.e. verification code) for the card number (e.g. CVV2; paragraph 0044 and 0143);

said determining step including determining whether said confirmation number is correct (paragraph 0044 and 0143);

storing in connection with said authorization website format information for each of a plurality of billers (paragraph 0010), retrieving the format information for a given

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biller and formatting said electronic notification in the format of the biller to whom authorization is sent (e.g. merchant controls the appearance of the e-mail order confirmation; see Table 1).

As to claim 2, Byrne discloses a method as in Claim 1 including storing in connection with said authorization website format information for each of a plurality of billers (paragraph 0010), retrieving the format information for a given biller and formatting said electronic notification in the format of the biller to whom authorization is sent (e.g. merchant controls the appearance of the e-mail order confirmation; see Table 1).

As to claim 3, Byrne discloses a method as in Claim 1 in which the information received at said authorization website includes an e-mail address for the payor, and said notification sending step comprises sending said notification in the form of an e-mail sent directly to the payor through the worldwide web (paragraph 0045).

As to claim 4, Byrne discloses a method as in Claim 1 in which said determining step comprises a step selected from the group consisting of determining whether the payment will exceed the credit limit of the payor's credit or debit card (e.g. real-time credit card processing; paragraph 0040), and validating the payor's bank account (e.g. and transaction engines; paragraph 0049 and 0060-0075).

As to claim 7, Byrne discloses a method as in Claim 1 including the step of validating a credit or debit card to be used for payment and sending information of said validation to said biller prior to receipt of any request for authorization of a payment charged to said card (i.e. the card is pre-authorized; paragraph 0045).

As to claim 8, Byrne discloses a method as in Claim 1 including the step of reversing said authorization at the request of the biller given prior to the end of the business day in which said authorization was given, and notifying any bank or credit card organization to whom the payment was communicated (e.g. credit or void; paragraph 0041-0042 and 0105).

As to claim 10, Byrne discloses a method as in Claim 1 including said biller sending restrict/unrestrict instructions for the account of one or more customers, and storing said instructions in association with said authorization website, and retrieving and effectuating said instructions upon the receipt of a payment request for the account (e.g., reject orders from certain e-mail accounts or credit cards; paragraph 0149).

As to claim 12, Byrne discloses a method as in Claim 1 including said biller accumulating a plurality of payments to be authorized and sending them to said authorization website in a batch by means of a function call (paragraph 0147).

As to claim 20, Byrne discloses a system for authorizing bill payments, said system comprising:

(a) an authorization web server programmed for selective communication through the worldwide web with a plurality of billers' web servers (paragraphs 0010 and 0119; and FIG. 4 and 6);

(b) a programmed digital computer system linked to said authorization web server to obtain authorization information from financial institutions authorizing or rejecting payment requests received at said billers' web servers from payers' computers through the worldwide web and communicating authorization information to the appropriate billers' web servers by the use of web services programming (paragraphs 0010, 0028-0031 and 0119; and FIG. 4 and 6);

(c) said programmed digital computer system being programmed to send directly to the payer's computer originating the payment request an e-mail containing said authorization information (paragraph 0045).

As to claim 21, Byrne discloses a system as in Claim 20 in which said authorization information is sent to the payer's computer and the biller's web server substantially simultaneously (e.g. complex schema that contains the URL to post transaction response information back to the merchant and for sending confirmation e-mails; paragraph 0107).

As to claim 22, Byrne discloses a system as in Claim 20 in which information regarding the format desired for communications to consumers on behalf of each of a plurality of billers is stored and retrieved to place the e-mail message sent to the payer in the format desired by this biller whose bill is being paid (paragraph 0092-0093 and Table 1).

As to claim 24, Byrne discloses a system in Claim 20 in which said computer system is programmed to demand that credit/debit card confirmation numbers be submitted with any credit/debit card payment requests, and to use the confirmation number together with other credit card information to protect against fraud in obtaining authorization for credit/debit card payments (e.g. CVV2; paragraph 0044 and 0143).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claims 5-6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of Ensel et al. (hereinafter Ensel) Pat. No. 6493685.

As to claim 5, Byrne does not explicitly disclose a method as in Claim 1 in which said determining step comprises, in a request for payment from a bank account (i.e. ACH/EFT payment; paragraph 0049), communicating authorization, later submitting the transaction for bank clearance, and communicating failure of clearance to said biller if and when received.

However, Ensel teaches that in a method for an electronic account presentation and response system there is a process for accepting a payment from a bank account. Ensel teaches that the system generates an ACH debit to the customer to debit the account identified by the customer, and also credits the biller in the amount debited from the customer. If later the ACH does not clear, after two attempts, the system will debit the account of the biller. At this time, it is the responsibility of the biller to start a collection process against the customer (column 17, line 41 thru column 18, line 18). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Ensel within Byrne for the motivation of explaining the process of clearing an ACH/EFT payment.

As to claim 6, Byrne discloses a method as in Claim 5 in which said submitting step comprises accumulating a plurality of payment requests over a period of time, and

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submitting them for clearance in a batch after said period of time has elapsed (paragraph 0147).

As to claim 9, Byrne discloses a method as in Claim 1 including the step of storing at said authorization website basic billing information for each of a plurality of customers of a given biller, giving said biller access to the billing information for each of said customers to modify said information directly (i.e. update and maintain billing information; paragraph 0045 and 0089).

Byrne does not explicitly disclose giving each customer access to such billing information for the customer's account.

However, Ensel teaches that in a method for an electronic account presentation and response system customers are provided the capability to review their accounts and review and pay electronic versions of their bills (column 9, lines 4-20). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Ensel within Byrne for the motivation of maintaining web sites for providing information to their customers and for marketing their goods and or services (column 9, lines 4-20).

9. Claims 11, 18-19, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of Mersky et al.(hereinafter Mersky), Pat. No. 6119106.

As to claim 11, Byrne does not explicitly disclose a method as in Claim 1 including preliminarily providing a calculation of fees to the customer in response to supplying merely the amount and the means of payment.

However, Mersky teaches a method and apparatus (i.e. system) for facilitating customer payments to creditors from a remote site, where a service fee is charged to and paid by customers upon utilizing the payment service (column 4, lines 50-53). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Mersky within Byrne for the motivation of facilitating customer payments to creditors with various forms of payment (e.g., check, cash, credit card, etc.) from a remote site (e.g., a local retail establishment) (column 2, lines 10-16).

As to claims 18, Byrne discloses a method of authorizing bill payments (see Abstract), said method comprising:

(a) receiving at an authorization website information sent by a biller (e.g. merchant, seller) through the worldwide web identifying the payor, and specifying the amount to be paid and the account to be used in making the payment (paragraphs 0010 and 0119; and FIG. 4 and 6);

(b) determining whether the payment should be authorized (paragraph 0058);

(c) transmitting through the worldwide web to a website of the biller authorization information authorizing the payment or refusing authorization (paragraph 0058);

(d) whereby authorization notification (e.g. receipt) can be given to the payor from a website of the biller without disclosing that the authorization was obtained by anyone other than the biller (e.g. customer never leaves merchants site; see Table 1 and paragraph 0107).

Byrne does not explicitly disclose that the information (i.e. transaction information) received at said authorization website includes information identifying the billing personnel responsible for the bill or bills being paid, including the step of storing and reporting said billing personnel to the biller when reporting the authoritarian results.

However, Mersky teaches a method and apparatus (i.e. system) for facilitating customer payments to creditors from a remote site, where transaction files include a plurality of records, with each having information pertaining to a particular transaction. Mersky teaches that the information includes an agent number (column 9, lines 50-67). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Mersky within Byrne for the motivation of creating reports of the daily transactions, for each creditor (e.g. biller), that include all details for each transaction, including the agent responsible for enter the payment into the system (column 10, lines 1-67).

As to claims 19, Byrne discloses a method of authorizing bill payments (see Abstract), said method comprising:

(a) receiving at an authorization website information sent by a biller through the worldwide web identifying the payor, and specifying the amount to be paid and the account to be used in making the payment (paragraphs 0010 and 0119; and FIG. 4-6);

(b) determining whether the payment should be authorized (paragraph 0058);

(c) transmitting through the worldwide web to a website of the biller authorization information authorizing the payment or refusing authorization (paragraph 0058);

(d) whereby authorization notification can be given to the payor from a website of the biller without disclosing that the authorization was obtained by anyone other than the biller (e.g. customer never leaves merchants site; see Table 1 and paragraph 0107), and including one or more of the steps selected from the group consisting of:

(e) sending an electronic notification to the payor that the payment has been authorized (e.g. automatically e-mail payment confirmation; paragraph 0045);

(f) determining the correctness of the confirmation number of a credit or debit card used in the payment (paragraph 0044 and 0143).

Byrne does not explicitly disclose assigning an identification number for each transaction for a given biller and transmitting said identification number to said biller; or determining and reporting to the biller the identity of the billing personnel with the authorization result.

However, Mersky teaches a method and apparatus (i.e. system) for facilitating customer payments to creditors from a remote site, where each transaction is assigned an identification number and for transactions involving an agent (i.e. billing personnel), the agent number is included in the transaction record. Mersky also teaches that the

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information related to each transaction is communicated to the biller (e.g. creditor; column 9, line 33 thru column 10, line 67). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Mersky within Byrne for the motivation of creating records for each transaction, of each creditor (e.g. biller), where the records contain a plurality details on the particular transaction.

As to claim 23, Byrne does not explicitly disclose a system as in Claim 20 in which said computer system is programmed to apply a transaction number to each transaction for a specific biller, store said transaction numbers, and report them to that biller.

However, Mersky teaches a method and apparatus (i.e. system) for facilitating customer payments to creditors from a remote site, where each transaction is assigned an identification number and for transactions involving an agent (i.e. billing personnel), the agent number is included in the transaction record, which is stored in a database. Mersky also teaches that the information related to each transaction is communicated to the biller (e.g. creditor; column 9, line 33 thru column 10, line 67; and column 12, lines 10-12). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Mersky within Byrne for the motivation of creating and storing records for each transaction, of each creditor (e.g. biller), where the records contain a plurality details on the particular transaction.

As to claim 25, Byrne does not explicitly disclose a system as in Claim 20 in which said computer system is programmed to receive, store, and report to each biller the identity of the billing personnel responsible for obtaining the payment authorized.

However, Mersky teaches a method and apparatus (i.e. system) for facilitating customer payments to creditors from a remote site. Mersky teaches that the system receives, stores and reports to each biller (e.g. creditor) the identity of the billing personnel (e.g. agent) responsible for obtaining the payment authorized (column 9, line 33 thru column 10, line 67; and column 12, lines 10-12). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Mersky within Byrne for the motivation of creating records of each transaction, for each creditor (e.g. biller), where the records contain a plurality details on the particular transaction.

10. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of Lewis et al. (hereinafter Lewis), Pub. No. 20020029194.

As to claims 16, Byrne discloses a method of authorizing bill payments (see Abstract), said method comprising:

(a) receiving at an authorization website information sent by a biller (e.g. merchant, seller) through the worldwide web identifying the payor, and specifying the

amount to be paid and the account to be used in making the payment (paragraphs 0010 and 0119; and FIG. 4 and 6);

(b) determining whether the payment should be authorized (paragraph 0058);

(c) transmitting through the worldwide web to a website of the biller authorization information authorizing the payment or refusing authorization (paragraph 0058);

(d) whereby authorization notification (e.g. receipt) can be given to the payor from a website of the biller without disclosing that the authorization was obtained by anyone other than the biller (e.g. customer never leaves merchants site; see Table 1 and paragraph 0107).

Byrne does not explicitly disclose assigning an identification number for each transaction for a given biller and transmitting said identification number to said biller.

However, Lewis teaches a method and system for managing transactions over an electronic network accepts input of all transaction, participant and financial information and creates a secure, participant personalized and transaction-customized graphical user transaction interface, where participants can view, update and complete transaction details and documents over the electronic network. A database stores laws, requirements and customs for documents and procedures of all jurisdictions and potential participants (see Abstract and paragraphs 0068 and 0094). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Lewis within Byrne for the motivation to create a detailed electronic audit trail of a financial transaction and to enable appropriate parties to review that audit trail before and after closing of the transaction in

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order to ensure and document that each required step in the transaction was in fact taken in the proper way (see paragraph 0022).

As to claims 17, Byrne does not disclose a method as in Claim 16 including storing all transaction identification numbers for each of a plurality of billers and transmitting said numbers to the appropriate biller (i.e. appropriate parties) in a report of transactions during a given period of time.

Claim 17 is rejected on the same grounds as claim 16.

Conclusion

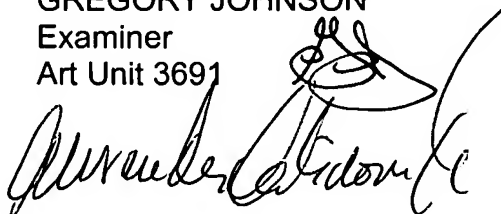
Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY JOHNSON whose telephone number is (571) 272-2025. The examiner can normally be reached on Monday - Friday, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GREGORY JOHNSON
Examiner
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A handwritten signature in black ink, appearing to read 'Gregory Johnson', is written over the printed name and title.

ALEXANDER KALINOWSKI
SUPERVISORY PATENT EXAMINER